

REMARKS

I. Status of the Claims

Upon entry of this Amendment, claims 24, 27-49 and 51-76 are pending in this application. Claims 25-33, 38-48, 50-73, and 76 were withdrawn from consideration by the Examiner. By this Amendment, claims 25, 26, and 50 were canceled without prejudice or disclaimer. Claims 24, 34, 49, 51, 74 and 75 were amended. Support for these amendments can be found throughout the specification and claims as filed. For example, support for "C₃-C₄₉ dialcohols" can be found in claims 34 and 40; support for "the concentration of said ester in said composition ranging from 1.2 to 8%" can be found in claims 50 and 52; and support for "the concentration of said washing base in said composition ranging from 6 to 35%" can be found in claim 26.

No new matter has been added by this proposed amendment nor does this amendment raise new issues or necessitate the undertaking of any additional search of the art by the Examiner. All of the elements and their relationships now claimed were earlier claimed in the claims as examined. Therefore, this Amendment under 37 C.F.R. § 1.116 should allow for immediate action by the Examiner. The proposed amendments, moreover, place the claims in condition for allowance or, at least, in better form for appeal, if necessary. Accordingly, Applicants respectfully request their entry.

II. Rejection Under § 103

The Examiner maintained the rejection of claims 24, 34-37, 49, 74, and 75 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,113,890 to Young et al. ("Young") for the reasons disclosed on pages 2-4 of the Office Action. Applicants traverse this rejection.

Applicants submit that the Examiner failed to satisfy the burden of proof for setting forth a prima facie case of obviousness. The Examiner has not made the requisite showing, as is set forth in M.P.E.P. § 2142, that there is some suggestion or motivation to modify the reference.

Although the Examiner concedes that Applicants' are correct in their assertion that sodium lauryl sarcosinate is not an amphoteric surfactant, the Examiner cites Example 1 of Young which comprises the anionic surfactant ammonium laureth and the amphoteric surfactant cocoamidopropyl betaine. Office Action at page 2. Applicants respectfully submit, however, that neither Example 1, nor any of the other examples of Young, teach the water-insoluble carboxylic acid esters wherein "the total number of carbon atoms of said at least one water-insoluble carboxylic acid ester not exceeding 27 if said at least one ester is saturated and not exceeding 50 if said at least one ester comprises at least one unsaturation," as recited in the present claims. The only esters expressly taught in the examples of Young, isocetyl stearyl stearate and ethylene glycol distearate (both of which do not comprise at least one unsaturation), exceed 27 carbons.

The Examiner also asserts that the carboxylic acid esters of the claimed invention is taught at column 10, lines 25-38 of Young. Office Action at page 3. As Applicants pointed out in the Response filed on March 8, 2004, however, the Examiner has shown no evidence why one skilled in the art would choose to select such a particular carboxylic acid esters from the myriad of carboxylic acid esters disclosed in

the reference. See Young at col. 10, lines 25-37. No guidance is provided in Young for such a selection. Moreover, there is no evidence why one skilled in that art would choose the claimed carboxylic acid ester from among the several different types of organic oils disclosed in Young. See Young at col. 9-11, lines 50-9. Indeed, the carboxylic acid esters are not even a requisite part of Young's invention, which further increases the already substantial amount of selection that would be necessary in an attempt to arrive at the claimed invention.

Although the Examiner asserts that "[t]he test of obviousness is 'whether the teachings of the prior art, taken as a whole, would have made obvious the claimed invention,'" Office Action at page 4, the Examiner has provided no reason why one skilled in the art would selectively pick and choose the various elements of the cited reference to arrive at the claimed composition. See *Ex Parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (Board of Appeals overturned Examiner's obviousness rejection because the Examiner provided no reasoning why the artisan would selectively pick and choose the various elements and concepts from the prior art to arrive at the claimed invention). Here the Examiner has done little more than show that each of the elements in the cited reference, when separately viewed in a vacuum, is known. As the Board of Appeals explained in *Ex Parte Clapp*

The claimed invention, however, is clearly directed to a combination of elements. . . . To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the

claimed invention to have been obvious in light of the reference teachings of the references.

Id. (emphasis added). For the reasons emphasized above, neither of these two requirements has been set forth in the Office Action.

Accordingly, for at least these reasons and the reasons of record, Applicants request that this ground of rejection be withdrawn.

III. Potential Objection Under 37 C.F.R. § 1.75

The Examiner states that “should claim 24 be found allowable, claims 35 and 36 will be objected to under 37 C.F.R. 1.75 as being a substantial duplicate thereof.” Office Action at page 4. Applicants respectfully disagree with the Examiner. Applicants submit that claims 35 and 36 are different in scope than claim 24 in that they further define the at least one water-insoluble carboxylic acid ester recited in the independent claim. For example, claim 35 recites that the “at least one of said esters [in the composition of claim 34] is chosen from the compounds from classes 1), 2), 4), 7) and 10). In contrast, claim 24 recites that the at least one ester can be chosen from 10 classes of esters, which are different in scope than the ten classes of esters recited in claim 34, upon which claims 35 and 36 depend.

Accordingly, there should be no basis to object to claims 35 and 36. The very provision the Examiner cites makes clear that Applicants have a right to restate the invention in a reasonable number of ways, which includes a mere difference in scope between the claims. M.P.E.P. § 706.03(k).

IV. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request entry of this Amendment, reconsideration of this application, and timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 22, 2004

By: 

Mark D. Sweet
Reg. No. 41,469